

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 9

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

AUG 27 2001
PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HARRY W. EBERLE, III

Appeal No. 2001-0217
Application No. 09/186,741

ON BRIEF

REMAILED

OCT 11 2001

PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Before CALVERT, McQUADE, and BAHR, Administrative Patent Judges.

McQUADE, Administrative Patent Judge.

DECISION ON APPEAL

Harry W. Eberle, III appeals from the final rejection of claims 18 through 29, all of the claims pending in the application.

THE INVENTION

The invention relates to an anchoring biscuit device for joining three boards. Representative claim 18 reads as follows:

18. An anchoring biscuit device for joining three boards, which comprises:

(a) a first substantially flat horizontal top element having a generally biscuit-shaped top view configuration with opposite side walls in the shape of arcs from a top view, said arcs having predetermined radii and arc lengths, said top element having a center area between said opposite side walls in the shape of arcs;

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(b) at least two substantially vertical support members attached to an underside of said top element at said center area of said top element and extending downwardly therefrom for a predetermined length to maintain said top element in a predetermined position during use for joining two adjacent boards which have been pre-cut with biscuit receiving slots, two of said at least two vertical support members being substantially flat, being in the same plane and one of each being located on opposite sides of an attachment orifice; and,

(c) at least one attachment orifice located at least on said top element for attachment of said anchoring biscuit device to a support board for anchoring and support of said two adjacent boards.

THE PRIOR ART

The references relied on by the examiner as evidence of obviousness are:

Ellinwood	2,362,252	Nov. 7, 1944
Bischof	5,529,428	Jun. 25, 1996
Wothe	372,483	Mar. 28, 1923
German Patent Document ¹		

THE REJECTIONS

Claims 27 through 29 stand rejected under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the subject matter the appellant regards as the invention.

¹ An English language translation of this reference, prepared by the United States Patent and Trademark Office, is appended hereto.

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Claims 18, 19 and 24 through 27 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ellinwood in view of Bischof.

Claims 20 through 23, 28 and 29 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ellinwood in view of Bischof and the German reference.

Attention is directed to the appellant's brief (Paper No. 7) and to the examiner's answer (Paper No. 8) for the respective positions of the appellant and the examiner with regard to the merits of these rejections.

DISCUSSION

I. The 35 U.S.C. § 112, second paragraph, rejection

The examiner considers independent claim 27, and claims 28 and 29 which depend therefrom, to be indefinite in that

[a]s concerns claim 27, the phrases "said at least two vertical support members", in line 10, and "and one of each being located on opposite sides of an attachment orifice", in lines 11-12, lack antecedent basis because "at least one...vertical support member", in line 6, is being claimed, therefore the claim is rendered vague and indefinite. Furthermore, there are two periods within the claim (i.e., lines 15 and 17) which is improper [answer, page 4].

The appellant acknowledges that "[t]he Examiner is correct" (brief, page 4), and proposes changes to claim 27 to be made by examiner's amendment in the event the claims are found to contain

allowable subject matter.²

In light of the appellant's position, we shall summarily sustain the standing 35 U.S.C. § 112, second paragraph, rejection of claims 27 through 29.

II. The 35 U.S.C. § 103(a) rejections

Ellinwood, the examiner's primary reference, discloses a "floating wall" system which employs a T-shaped element to attach wall and ceiling panels to underlying studs in a "floating" manner. As shown in the drawing figures, the T-shaped element, which is affixed to the stud by a nail 28, comprises a base 24 which engages the stud 10 and side flanges 25 which extend partially into grooves 20 in the confronting edges of adjacent panels 11.

Contrary to the findings made by the examiner (see pages 4 and 5 in the answer), Ellinwood's T-shaped element does not respond to the limitations in independent claims 18 and 27 requiring a substantially flat horizontal top element having "a generally biscuit-shaped top view configuration," the limitation in claim 18 requiring "at least two" substantially vertical

² For the sake of consistency, the amendments to claim 27 proposed by the appellant should also include the deletion of the words "two of" and "being in the same plane." Furthermore, the term "said vertical support member" in claim 24 lacks a proper antecedent basis and should be amended to read as - said vertical support members-.

support members attached to an underside of the top element, or the limitation in claim 27 requiring the vertical support member to be "located off-center and to one side of" an attachment orifice. As conceded by the examiner (see page 5 in the answer), Ellinwood's T-shaped element also fails to respond to the limitations in claims 18 and 27 requiring the substantially flat horizontal top element to have "opposite side walls in the shape of arcs from a top view, said arcs having predetermined radii and arc lengths."

Bischof discloses a workpiece connecting element consisting of a flat, arc-shaped, lamellar part 3 adapted to fit into an arc-like groove 6 in a first workpiece 1 and a bolt-like part 4 welded to the lamellar part and adapted to fit into a hole 8 in a second workpiece 2. Bischof also discloses a drilling template (see Figure 9) having a plurality of arc-shaped components. The stated purpose of the drilling template is to facilitate the drilling of a transverse hole 7 in the first workpiece 1 (see column 4, lines 25 through 37).

In proposing to combine Ellinwood and Bischof to support the § 103 rejections, the examiner, making reference to the drilling template shown in Bischof's Figure 9, concludes that it would have been obvious to one of ordinary skill in the art at the time the invention was made

to modify the side walls of Ellinwood by forming them as having an arc having a radii and an arc length, as

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taught by Bischof, in order to decrease the friction between the biscuit and the attached elements and thereby increase the ease as to which the biscuit can be initially set into place [answer, page 5].

The fair teachings of Ellinwood and Bischof, however, do not justify this conclusion. To begin with, Bischof's drilling template, and particularly the shape thereof, have no meaningful structural or functional relevance to the T-shaped connecting element disclosed by Ellinwood. Although Bischof's connecting element is somewhat more pertinent, its structure and function still differ markedly from those of Ellinwood's connecting element. The friction-reducing rationale advanced by the examiner to support the combination of these two references is quite strained, and highlights the impermissible hindsight-driven impetus for the combination. Moreover, even if Ellinwood and Bischof were combined in the manner proposed, the result would still not respond to the limitation in claim 18 requiring "at least two" substantially vertical support members attached to an underside of the top element or the limitation in claim 27 requiring the vertical support member to be "located off-center and to one side of" an attachment orifice. These flaws in the basic Ellinwood-Bischof combination find no cure in the German reference.

Thus, the prior art relied on by the examiner fails to establish a prima facie case of obviousness with respect to the

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subject matter recited in independent claims 18 and 27.³
Accordingly, we shall not sustain the standing 35 U.S.C. § 103(a) rejection of claims 18 and 27, and dependent claims 19 and 24 through 26, as being unpatentable over Ellinwood in view of Bischof, or the standing 35 U.S.C. § 103(a) rejection of dependent claims 20 through 23, 28 and 29 as being unpatentable over Ellinwood in view of Bischof and the German reference.

SUMMARY

The decision of the examiner:

- a) to reject claims 27 through 29 under 35 U.S.C. § 112, second paragraph, is affirmed; and
- b) to reject claims 18 through 29 under 35 U.S.C. § 103(a) is reversed.

³ This being so, it is not necessary to delve into the merits of the 37 CFR § 1.132 Declaration of Harry W. Eberle, III, filed November 18, 1999 as part of Paper No. 3, which has been proffered by the appellant as evidence of non-obviousness.

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No period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

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Administrative Patent Judge

John P. McQuade
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